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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Lawrence A. Denenberg

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04/19/2006

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EXAMINER

GAUTHIER, GERALD

ART UNIT

PAPER NUMBER

2614

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/912,352

Applicant(s)

DENENBERG ET AL.

Examiner

Gerald Gauthier

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 27, 2006 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. **Claim(s) 1-64** are rejected under 35 U.S.C. 103(a) as being unpatentable over Picard et al. (US 6,233,318 B1) in view of Bulfer et al. (US 6,446,114 B1).

Regarding **claim(s) 1, 48 and 52**, Picard discloses a messaging system (FIG. 1 and column 1, lines 13-19), wherein:

each of a plurality of messages is associated with at least two attributes (FIG. 7 and column 6, lines 35-39); and

the plurality of messages are enabled to be interactively categorized according to the at least two attributes into overlapping lists of messages by a recipient of the plurality of messages via said user interface (FIG. 7 and column 6, lines 42-55).

Picard fails to disclose including a telephone based voice user interface.

However, Bulfer teaches a telephone based voice interface (column 3, lines 12-20).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Picard using the teaching of telephone network as taught by Bulfer.

This modification of the invention enables the system to have a telephone network interface so that the user would retrieve messages through the telephone.

Regarding **claim(s) 2, 7, 14, 19, 53 and 58**, Picard discloses the at least two attributes comprise an urgency indicator and a message received date (column 6, lines 47-55).

Regarding **claim(s) 3, 8, 15, 20, 54 and 59**, Picard discloses the at least two attributes further comprise a message medium indicator (column 6, lines 47-55).

Regarding **claim(s) 4, 9, 16, 21, 55 and 60**, Picard discloses the at least two attributes further comprise a message sender identity indicator (column 6, lines 47-55).

Regarding **claim(s) 5, 10, 11, 17, 22, 23, 56, 61 and 62**, Picard discloses each of the plurality of messages is associated with a status that can represent one of at least three distinct statuses (column 6, lines 47-55).

Regarding **claim(s) 6, 12, 18, 24, 57 and 63**, Picard discloses the at least three distinct statuses comprise "new" "old" and "read" (column 6, lines 47-55).

Regarding **claim(s) 13**, Picard in combination with Bulfer disclose all the limitations of **claim(s) 13** as stated in **claim(s) 1**'s rejection above and furthermore Picard discloses a memory storing a plurality of messages (FIG. 8 and column 17, line 66 to column 18, line 4).

Regarding **claim(s) 25 and 27**, Picard discloses the system can select a list of messages for presentation comprising an intersection of at least two of the overlapping lists (column 6, lines 47-55).

Regarding **claim(s) 26 and 29**, Picard discloses the system selects the list of messages for presentation in response to a user input (column 6, lines 35-55).

Regarding **claim(s) 28**, Picard discloses the intersection is a logical AND or logical OR of the at least two of the overlapping lists (column 6, lines 47-55).

Regarding **claim(s) 30 and 49**, Picard in combination with Bulfer disclose all the limitations of **claim(s) 30 and 49** as stated in **claim(s) 1**'s rejection above and furthermore Picard discloses receiving the newly-arrived message during a session using a telephone based voice user interface (FIG. 8 and column 20, lines 56-59); and presenting the newly-arrived message to a user who is an intended recipient of new arrived message before the user takes action to end the session (FIG. 8 and column 20, lines 2-22).

Regarding **claim(s) 31, 33 and 35**, Picard discloses the newly-arrived message is presented only if the newly-arrived message is urgent (column 6, lines 47-55).

Regarding **claim(s) 32 and 37**, Picard discloses interrupting presentation of a message to present the newly-arrived message (column 20, lines 56-59).

Regarding **claim(s) 34, 38 and 51**, Picard discloses presenting the newly-arrived message before presenting any other message (column 20, lines 56-59).

Regarding **claim(s) 36**, Picard discloses ascertaining, in accordance with:
a command issued by the user during the session, but prior to the receiving the newly-arrived message, and attributes of the newly-arrived message, whether the system would have presented the newly-arrived message earlier in the session if the newly-arrived message had arrived earlier in the session (column 20, lines 56-59).

Regarding **claim(s) 39**, Picard discloses if the newly-arrived message would not have been presented earlier in the session, including the newly-arrived message in a currently-selected set of message to present to the User (column 20, lines 56-59).

Regarding **claim(s) 40 and 50**, Picard discloses the newly-arrived message is presented before the user changes message selection criteria (column 20, lines 56-59).

Regarding **claim(s) 41**, Picard discloses adding the newly-arrived message to a set of messages that are currently selected for presentation (column 20, lines 56-59).

Regarding **claim(s) 42**, Picard in combination with Bulfer disclose all the limitations of **claim(s) 42** in the **claim(s) 30'** s rejection above and furthermore Picard discloses responsive to a user command issued during a session, selecting a set of messages to present to the user, the user being an intended recipient of the newly arrived message (FIG. 8 and column 18, lines 13-42).

Regarding **claim(s) 43**, Picard discloses the newly-arrived message is included in the set of messages to present to the user only if attributes of the newly-arrived message satisfy all selection criteria associated with the user command (column 20, lines 56-59).

Regarding **claim(s) 44 and 46**, Picard discloses at least one of the at least two attributes corresponds to at least one non-user-defined field in an address book (column 18, lines 5-12).

Regarding **claim(s) 45 and 47**, Picard discloses at least one of the at least two attributes corresponds to at least one user-defined field in an address book (column 18, lines 5-12).

Regarding **claim(s) 64**, Picard in combination with Bulfer disclose all the limitations of **claim(s) 64** as stated in **claim(s) 1**'s rejection above and furthermore Picard discloses sorting the messages according to multiple attributes thereof, an addressee of the messages having at least partial control over a sort order of the messages using a telephone based voice user interface (FIG. 7 and column 6, lines 42-46); and

providing the sorted messages to the addressee of the messages (FIG. 7 and column 6, lines 47-62) .

Response to Arguments

6. Applicant's arguments with respect to **claim(s) 1-64** have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2614

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


GERALD GAUTHIER
PATENT EXAMINER

g.g

April 17, 2006